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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. | | |
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| 10/716,464 | 11/20/2003 | Hidehiko Fujiwara | Q78503 | 6839 | | |
| 23373 | 7590 | 12/09/2008 | EXAMINER | | | |
| SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE, N.W. SUITE 800 WASHINGTON, DC 20037 | | | | WONG, XAVIER S | | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/716,464 | FUJIWARA ET AL. | |
| | Examiner | Art Unit | |
| | Xavier Szewai Wong | 2416 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 8th Septemeber 2008.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-4 and 7-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-4 and 7-10 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ . |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ . | 6) <input type="checkbox"/> Other: _____ . |

DETAILED ACTION

Response to Arguments

Applicant's arguments with respect to claims 1 and 2 have been considered but are not persuasive.

1. Applicants argue that Ranalli does not disclose "inputting a telephone number into a mobile phone unit, the input telephone number then being converted by a VoIP extension section (remarks, pg. 5 lines 1-2)" and no suggestion that END_USER 1 or END_USER 2 have "respective directories (or calling lists) (remarks, pg. 4 lines 10-13)." The *main focus* is that Ranalli brings in the *concept* of a "*directory service*" that performs "*convert[ing]* unique identifiers (e.g. standard telephone numbers) into corresponding network addresses... allowing *end users* to utilize non-Internet related unique identifiers (e.g. telephone numbers) [0039 lines 1-9]." In this case, the so-called "unique identifiers" are interpreted as "input telephone number(s)" and the so-called "corresponding network addresses" are interpreted as "private telephone number(s)" in broad sense.
2. Regarding the "respective directories" of the END USERS, it is well-known in the communication art that directories exist in the END USER mobile phones and that in order to make a call from the end user mobile phone as if a private phone, the end user unique number *must* be entered, manually or automatically detected, regarding the end user himself / herself in order for the "*directory service*" of Ranalli to convert the unique number into the private number, thus, it is read that the unique number from the end user directory and the private number *must* be linked to the directory in order for the

conversion to take place, or else, the directory service would have no previous knowledge of either unique or private numbers if they are not linked in some ways.

3. Also, in response to applicant's argument that Ranalli is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Ranalli is an analogous art since Ranalli teaches the *concept* of using the directory service to convert a telephone number to a "private identifier or number" in an IP-PBX environment to avoid excessive charges (or to use the service at a lower fee) if a public caller is trying to use the private service (see: abstract; [0006, 0016]).

Claim Objections

Claim 1 is objected to because of the following informalities –

Lines 2-3: delete "IP-PBX (Internet Protocol - Private Branch eXchange)" and replace with -- Internet Protocol - Private Branch eXchange (IP-PBX) --; Line 3: delete "IP (Internet Protocol)" and replace with -- Internet Protocol (IP) --; Line 5: delete "VoIP (Voice over IP)" and replace with -- Voice over IP (VoIP) --.

Claim 2 is objected to because of the following informalities –

Line 2: delete "IP-PBX" and add -- Internet Protocol - Private Branch eXchange (IP-PBX) --; Line 2: delete "IP" and add -- Internet Protocol (IP) --; Line 7: delete "VoIP" and add -- Voice over IP (VoIP) --.

Claims 7 and 8 are objected to because of the following informalities –

Line 2 (both claims): delete “QoS (Quality of Service)” and replace with -- Quality of Service (QoS) --.

Appropriate corrections are required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each

claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1 – 4, 9 and 10, are rejected under 35 U.S.C. 103(a) as being unpatentable over **Waseda et al (JP 2001-54151 A)** in view of **Ranalli et al (US 2003/0076933 A1)**.

Claim 1: **Waseda** et al disclose in figure 6 an adaptor (connector 20) being connectable to a mobile phone unit (mobile phone 30) through a low power wireless system or a wired cable and connected to an IP-PBX (PBX 10) through an IP network (internet “IP” 100/200), comprising:

a telephone unit controller (fig. 6: mobile unit controller 22) for managing resource data of the mobile phone unit (paragraphs 0011-13 & 0016: communications control).

Nonetheless, **Waseda** et al does not have specifically disclose a VoIP extension section converting an input telephone number into a telephone number of a private IP telephone corresponding to the input number when the input telephone number is inputted into the mobile phone unit and calling the telephone number of a private IP telephone; and means for linking a telephone directory of the mobile phone unit and a telephone directory of the IP-PBX. **Ranalli** et al teach a VoIP extension (Directory Service) section converting an input telephone number into a telephone number of a private IP telephone corresponding to the input number when the input telephone number is inputted into the mobile phone unit and calling the telephone number of a private IP telephone ([0039]: a Directory Service (DS) converts “unique identifiers” – such as a

standard public mobile number – to a corresponding IP address for e.g. an IP-PBX); and means (DS) for linking a telephone directory of the mobile phone unit and a telephone directory of the IP-PBX (paragraphs 0015-16, 0021-22, 0135-136, 0147, 0178; fig. 5: the DS links a standard mobile end user to an IP-PBX by storing the phone numbers or identifiers of the mobile end user and the IP-PBX; in order to recognize both the mobile and the IP-PBX number or identifier, their respective directories (or calling lists) are required to be registered into the DS database, therefore, such function reads on as linking a telephone directory of the mobile phone unit and a telephone directory of the IP-PBX). It would have been obvious to one of ordinary skill in the art at the time the invention was created to implement the features of the DS as taught by **Ranalli** et al to the adaptor of **Waseda** et al for facilitate and expedite communications between a public (e.g. mobile) phone and a private (e.g. IP-PBX) phone.

Claim 2: **Waseda** et al disclose in figure 6 an adaptor (connector 20) being connectable to a mobile phone unit (mobile phone 30) through a low power wireless system or wired cable and connected to an IP-PBX (PBX 10) through an IP network (internet “IP” 100/200), comprising:

a telephone unit controller determining whether or not the mobile phone unit has been connected to the adaptor when a call to a telephone number of a private IP telephone is received ([0053-54; 0060]: when a call is received to the private phone’s number, the connection status of the mobile phone – connected to connector or not – is determined);

Nonetheless, **Waseda** et al does not have specifically disclose a *VoIP* extension section converting an input telephone number into a telephone number of a private IP telephone corresponding to the input number when the input telephone number is

inputted into the mobile phone unit and calling the telephone number of a private IP telephone; and means for linking a telephone directory of the mobile phone unit and a telephone directory of the IP-PBX. **Ranalli** et al teach a Vo/P extension (Directory Service) section converting an input telephone number into a telephone number of a private IP telephone corresponding to the input number when the input telephone number is inputted into the mobile phone unit and calling the telephone number of a private IP telephone ([0039]: a Directory Service (DS) converts “unique identifiers” – such as a standard public mobile number – to a corresponding IP address for e.g. an IP-PBX); and means (DS) for linking a telephone directory of the mobile phone unit and a telephone directory of the IP-PBX (paragraphs 0015-16, 0021-22, 0135-136, 0147, 0178; fig. 5: the DS links a standard mobile end user to an IP-PBX by storing the phone numbers or identifiers of the mobile end user and the IP-PBX; in order to recognize both the mobile and the IP-PBX number or identifier, their respective directories (or calling lists) are required to be registered into the DS database, therefore, such function reads on as linking a telephone directory of the mobile phone unit and a telephone directory of the IP-PBX). It would have been obvious to one of ordinary skill in the art at the time the invention was created to implement the features of the DS as taught by **Ranalli** et al to the adaptor of **Waseda** et al for facilitate and expedite communications between a public (e.g. mobile) phone and a private (e.g. IP-PBX) phone.

Claims 3 and 4: **Waseda** et al, as modified by **Ranalli** et al, disclose when a (private) phone *T11* receives a call, and if the mobile phone connector/adaptor *30* is not connected to the mobile phone, then the call is transferred/forwarded to a designated terminal (phone number) according to a database *D9* inside PBX *10*; else if there is not a

designated number, then the call is transferred/forwarded to the mobile phone 30 (paragraphs 0064-65; claim 18; fig. 16).

Claims **9** and **10**: **Waseda** et al, as modified by **Ranalli** et al, disclose the claimed invention yet did not explicitly mention a battery charger for the mobile phone – **Waseda** et al disclose a “current source” (power supply 25) inside the adaptor 20 that can draw power from the PBX (paragraph 0049; fig. 6) – the examiner takes official notice that it would have been obvious to a person of ordinary skill in the art at the time of the invention was made to incorporate the teachings of an adaptor comprising a battery charger for a mobile phone to act as an alternative power source for the mobile phone.

Claims **7** and **8** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Waseda** et al (**JP 2001-54151 A**) in view of **Ranalli** et al (**US 2003/0076933 A1**), as applied to claims **1** and **2**, in further view of **Keenan** et al (**U.S 6,577,631 B1**).

Claims **7** and **8**: **Waseda** et al, as modified by **Ranalli** et al, disclose the claimed invention except the adaptor comprising a QoS controller for minimizing audio data loss due to congestion over an IP network. **Keenan** et al disclose a User Terminal Equipment (UTE) adapter, which is compatible to be inserted into a digital (mobile) phone, comprising controlling mechanism for Quality of Service (QoS) characteristics such as audio and video delay sensitive information when congestion occurs in an Internet/Ethernet (IP) access environment (col. 1 lines 36-53, col. 5 lines 60-66, col. 7

lines 4-25, col. 8 lines 46-66, col. 10 lines 9-23 & col. 23 lines 50-57; figs. 3 & 4). It would have been obvious to a person of ordinary skill in the art at the time of the invention was made to incorporate the teachings of an adaptor comprising a QoS controller, as taught by **Keenan** et al, in the adaptor of **Waseda** et al, as modified by **Ranalli** et al, in order to minimize audio/video data loss and long delays due to congestion over an IP/Ethernet network.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

1. Forte, US 7274782 B2: a first mobile phone user dials a phone number of a second mobile phone user who is registered in a private IP PBX environment wherein the phone number of the second mobile user is converted into a private extension number when the second mobile user phone number is unreachable due to the second mobile phone user being in a location within a private enterprise
2. Brunner et al, US 6263211 B1: a wireless office system (WOS) for automatically setting a frequency of a mobile station roaming in both public and private environments
3. Roeder, US 7003287 B2: call forwarding to a PBX
4. Brookings et al, US 6920318 B2: a private network is operable to transmit a message to a mobile station wherein the mobile station has a corresponding mobile station ID and a message recipient user is assigned to the mobile station ID in the

private network; wherein a sender need not have knowledge of the ID for the mobile station

5. Rautiola et al, US 5956331: integrated radio communication system wherein internal telephone calls in the office are free of charge

6. Eynard et al, US 7039401 B2: masking function to handle internetworking with public mobile network, filtering function to analyze numbering of internal call or calling customer in relation to identity of the calling or called party

7. Grundvig et al, US 6122502: allowing a cordless phone user to use the same cordless phone handset with multiple cordless telephone base units based on roaming proximity

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any response to this Office Action should be **faxed to (571) 273-8300 or mailed to:**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Hand-delivered responses should be **brought to:**

Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Xavier Wong whose telephone number is (571) 270-1780. The examiner can normally be reached on Monday through Friday 8 am - 5 pm (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Seema Rao can be reached on (571) 272-3174. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call (800) 786-9199 (IN USA OR CANADA) or (571) 272-1000.

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/Xavier Szewai Wong/

X.S.W
4th December 2008

/Ian N. Moore/

Primary Examiner, Art Unit 2416